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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,827	08/24/2000	Toshiki Taru	50395-068	5605

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EXAMINER	
HOFFMANN, JOHN M	

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 06/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622,827

Applicant(s)

TARU ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

Figures 8-10 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claim 6 embodiment where the inner member is at the lower side and the outer member is at the upper side and the inner member is supported by placing the outer member on the inner member must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. This must be shown for the plural sets.

The drawings must also show a an auxiliary heater outside a vicinity of the upper end - as per claim 10. Heater 18 is clearly in the vicinity of the upper end - it is not outside the vicinity.

The drawings must also show claim 11 invention of the preform supported by dummy rod at an upper part of the dummy rod and which upper part is inside the muffle tube. All of the present drawings show the dummy rod being above the muffle tube. Furthermore, the drawings only show the preform being suspended by a dummy rod at a lower end thereof.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Page 9, lines 18-19 of the specification indicate that a set of separating plates may be a single plate. However to one of ordinary skill a "set" of "plates" requires a plurality of plates. Although Applicant is entitled to be their own lexicographer, such doesn't entitle Applicant to redefine well accepted terms in a manner that is repugnant to all their accepted meanings. The claim is unclear as to whether a "set of separating plates" actually needs more than one plate.

Claim 6, lines 12 and 13 refer to "the upper side" and "the lower side". There is no antecedent basis for these terms. More importantly, there is no indication as to the sides of what. Claim 5 refers to "lower end" and "upper part" and claim 1 refers to completely different "lower end" and "upper part". It is unclear if the sides correspond to the lower ends or the upper parts.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-5, 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi 6-199536.

See figure 2: Tubes 13 and 15 are deemed to comprise the muffle tube. The upper tube is deemed to be an "inner tube" in that it would have been obvious to have the structure indoors to keep the elements off of it. As to the steps of arranging, melting, drawing, blowing, etc. such are method of use steps and have no importance in an apparatus claim. Alternatively, any relevance they have is clearly met by the reference 26 is a set of two plates. 28 is the a gas blowing port.

Claim 2 further limits "said plural sets". However claim 1 does not require plural sets. Claim 1 is directed to the genus which permits the specie of single set and the specie of plural sets. Claim 2 does not effect limit an invention that meets the single "set" specie - only the plural "sets" specie. In other words, claim 2 does not require the "sets" specie - it merely limits that specie if that is the specie which is being compared to the claim. Since claim 2 does not limit the single "set" specie, it does have any limitation that would exclude Kobayashi - which is a member of the single set specie.

Likewise, claim 4 limits the plural sets - but not a single set. Unlike claim 2, it has other limitations (such as to the dummy rod). However all of these limitations

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are relative to the plural sets. There is no limitation that is relative to a single set. Thus it is deemed that the limitations are directed to the specie where there are plural sets and have no relevance on the specie where there is but a single set.

Claim 5 is clearly met.

Claim 7, requires a step of providing protrusions on the outer periphery of the separating plate. This is a method of use limitation - which has little bearing on the structure of the apparatus claims. It is clear one could put downward protrusions on the Kobayashi plates. However, if the claim is not directed to a method of use, the claim is directed to the specie where the set of separating plates where there is only one separating plate - since it refers to "the separating plate". The claim does not limit the specie that has more than one plate - such as Kobayashi.

Claim 8 and 9 also are directed to the single plate specie and are silent as to further limiting more than one separating plate.

Claim 10, it would have been obvious to provide a furnace to heat the room that the apparatus is in, so that people who work there are comfortable in the winter. Such a furnace is outside the vicinity. Alternatively, the step of arranging is a method of use limitation is not a structural limitation that is relevant to the claimed furnace structure. As to heating the upper space, such is a method of use limitation.

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito 6138481.

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Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Looking to figure 1 of Saito. The preform is clearly supported by the dummy rod 2B at an upper part thereof. However there is no indication that the upper part was within muffle tube - it would have been obvious that the upper end of the dummy rod was inside muffle tube 9, otherwise, the lower end of the preform 1, could never have been melted to be drawn thinner.

As to the inner tube being connected to an end of the muffle tube, it is noted that Saito tube 9 is shown to be suspended in the middle of chamber 5. Clearly some structure must be used to the other structure - otherwise it will fall. IT would have been obvious to provide something connect to the tube to the other structure. Further, it would have been obvious to do the connections at one of the ends of the tube, since those are the cooler ends, and if the connections were at the middle of the tube (9) it would be additional thermal mass that would likely cause uneven heat distribution. An end is clearly the most convenient place to connect the tube. And since tube 8a is connected to the rest of the structure, the two tubes are at least indirectly connected to each other. As indicated in Applicant's drawings, the two tubes the don't appear to be directly connect, there appears to be structure in between them. One would not assume that Applicant intended to require a direct connection - which could easily be overcome by using a spacer material between the tubes.

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AS to the step of melting, it would have been obvious to melt the rod and draw it into a fiber after it is stretched by the Saito method, because its intended use is to be melted and drawn to form a fiber.

As to the last half of the claim, it starts out "while one set or plural sets of separating plates are arranged...." There is not a positive recitation of a step of arranging plates - so it is not interpreted as such. If applicant wishes to recite a particular step, it should be clearly indicated as such. The claim makes no restrictions if there are no plates arranged in the tube. Since Saito does not arrange separating plates, the subsequent limitations are irrelevant.

Likewise for claim 12, there is no positively recited step. Since Saito does not have an auxiliary heater, the particular heating and melting steps need not be discussed.

Allowable Subject Matter

Claims 3 and 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

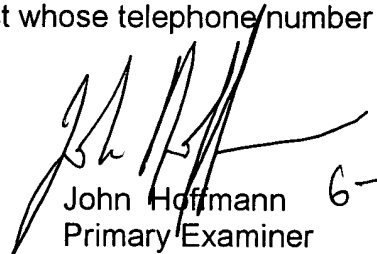
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Janssen, Klop, Orita, Drouart, Sumitomo(2), Nippon, Furukawa, and Koaizawa are cited as being of general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is 703-308-0469. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7115 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


John Hoffmann
Primary Examiner
Art Unit 1731
6-18-2002

jmh
June 18, 2002